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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,160	02/13/2002	Hartmut Strobel	04734-0003	4730

7590 03/19/2003  
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Washington, DC 20005-3315

EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/073,160	<b>Applicant(s)</b> STROBEL ET AL.	
	<b>Examiner</b> Kamal A Saeed	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

Claims 1-26 are pending in this application.

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 21 and 22, are drawn to compounds and compositions of Formula I, depicted in claim 1, variously classified in classes 514, 544, 546, 548, and several subclasses.
- II. Claims 7-20, are drawn to a method of use of compounds and compositions of Formula I, depicted in claim 7, variously classified in classes 514, 544, 546, 548, and several subclasses.
- III. Claim 23, is drawn to a method of preparing, compounds and compositions of Formula I, depicted in claim 1, variously classified in classes 544, 546, 548, and several subclasses.

The inventions are distinct, each from the other because of the following reasons:

Invention Groups I and Group III are related as product and process of making thereof.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another materially different process (MPEP 806.05(f)). In the instant case, the product as claimed can be made by another materially different process as is clearly evident from the examples in pages 133-136. Therefore a separate search considerations are involved, which would impose a burden if unrestricted.

Invention Groups I and II are related as a product and method of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using

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the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different method of using the product (MPEP 806.05(h)). In the instant case, the product as claimed can be used in a materially different method of using the product as demonstrated throughout the specification and in claims 14-20. Therefore a separate search considerations are involved, which would impose a burden if unrestricted.

Accordingly, along with the election of one of the above groups, the following action is also taken. Claim 1 is generic to a plurality of disclosed patentably distinct species comprising, for example, the compositions of compounds of (1) Example 2, page 47; Example 3, page 47 etc. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Upon the election of a single disclosed species (e.g. Example, page number and structural depiction), a generic concept, inclusive of the elected species, will be identified by the Examiner for examination. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

In accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised the process of use are amended during prosecution to maintain either dependency on the product claims or to otherwise include limitations of the product claims.

**Failure to do so may result in a loss of the right to rejoinder.**

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right)

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"Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application.

This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D  
March 3, 2003

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1